

Serial No.: 09/475,830

Attorney Docket No.: 11710-0111

Page 3

the amendments is found throughout the specification, for example, at on page 4, lines 10-22, and in original claims 16, 17, and 28.

## **I. FORMAL REJECTIONS**

### Claim Rejections under 35 U.S.C. § 112, 2<sup>nd</sup> paragraph

Claims 1-15, 19-23, and 31-32 were rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. In particular, the Examiner remarks that the claims are indefinite because they merely set forth physical characteristics desired in an article and do not set forth specific compositions. The Examiner furthered that "Claims 1-15, 19-23, and 31-32 would impart desired characteristics too broad and indefinite since it purports to cover everything which will perform the desired functions regardless of its composition, and, in effect, recites compounds by what it is desired that they do rather than what they are." In final, the Examiner states, "[t]he claims do not define any particular structure or compositions, which would allow a proper comparison to the prior art."

The second paragraph of 35 U.S.C. § 112 requires claims to set out and circumscribe a particular area with a reasonable degree of precision and particularity. *See In re Johnson*, 558 F.2d 1008, 1015 (C.C.P.A. 1977). This requirement mandates claims are clear what subject matter they encompass and thus what the patent

precludes others from doing. *See In re Conley*, 409 F.2d 972 (C.C.P.A. 1974). In making this determination, the definiteness of the language employed in the claims must be analyzed, not in a vacuum, but always in light of the teachings of the prior art and of the particular application disclosure as it would be interpreted by one possessing the ordinary level of skill in the pertinent art. *See Johnson*, 558 F.2d at 1015.

Despite the Examiner's contentions, functional language is not objectionable in and of itself. *See* MPEP § 2173.05(g). "There is nothing indefinite in the use of claim language which defines particular amounts according to a functional criterion." *In re Spiller*, 500 F.2d 1170 (C.C.P.A. 1974) (*citing In re Fuetterer*, 319 F.2d 259 (1963), *In re Swinehart*, 439 F.2d 210 (C.C.P.A. 1971)). By definition, "functional" language defines an invention by what it does rather than what it is. *See Swinehart*, 439 F.2d at 212-213. Specifically, the *Swinehart* court remarked, "[w]e take the characterization 'functional' to indicate nothing more than the fact that an attempt is being made to define something (in this case, a composition) by what it does rather than by what it is (as evidenced by specific structure or material, for example)." *Id.* at 212. In fact, courts have "recognized the practical necessity for the use of functional language." *Id.* at 212.

Serial No.: 09/475,830

Attorney Docket No.: 11710-0111

Page 5,

The proper treatment of a functional limitation is to treat the limitation as a "means plus function" claim under 35 U.S.C. § 112. *See In re Chandler*, 254 F.2d 396 (C.C.P.A. 1958). *See also In re Oelrich*, 666 F.2d 578 (C.C.P.A. 1981); *Raytheon Co. v. Roper Corp.*, 724 F.2d 951 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 835 (1985). "The USPTO must apply 35 U.S.C. 112, sixth paragraph in appropriate cases, and give claims their *broadest reasonable interpretation, in light of and consistent with the written description in the application.*" MPEP § 2181. Moreover, "[b]readth is not indefiniteness." *In re Gardner*, 427 F.2d 786 (C.C.P.A. 1970).

When the present invention's claims are read in light of the disclosure, including the comparative examples, the claims are sufficiently clear. *See, for example, In re Robins*, 429 F.2d 452 (C.C.P.A. 1970). For instance, on page 4, lines 10-22 of the specification, the description reads:

The absorbent composites contain superabsorbent materials, which have a Gel Bed Permeability (GBP) value of greater than about  $70 \times 10^{-9} \text{ cm}^2$  and an Absorbency Under Load (AUL) value of less than about 25 g/g at 0.6 psi (41,370 dynes/cm<sup>2</sup>). This combination of properties for superabsorbent materials enables an absorbent composite to have improved fluid intake rate and superior fluid intake of multiple insults over the life of the composite. Unlike known absorbent composites, which lose their fluid intake performance over the life of the composite, the absorbent composites of the present invention perform exceptionally well, exhibiting superior fluid intake after multiple insults to the composite.

Similarly, on page 6, lines 33-37 to page 7, lines 1-8, the invention is described as follows:

The present invention is directed to a method of achieving optimum performance in an absorbent composite due to the discovery that superabsorbent materials having a high Gel Bed Permeability (GBP) value and a low Absorbency Under Load (AUL) value at 0.6 psi (41,370 dynes/cm<sup>2</sup>) provide unexpected intake performance improvement over known superabsorbent materials. More specifically, superabsorbent materials having, in combination, a Gel Bed Permeability (GBP) value of greater than about  $70 \times 10^{-9}$  cm<sup>2</sup> and an Absorbency Under Load (AUL) value of less than about 25 g/g at 0.6 psi (41,370 dynes/cm<sup>2</sup>), provide desirable properties and performance to absorbent composites. These lower capacity superabsorbent materials have the capability of delivering improved intake performance as described below.

Both of these excerpts define Applicants' claimed invention clearly by what the composition is supposed to do as mandated by *Swinehart*. In addition, Example 1 and the corresponding Table 5 as well as Example 3 and the corresponding Table 7 clearly depict what the present invention does that the prior art does not. Accordingly, Applicants respectfully request withdrawal of this rejection.

## II. CONCLUSION

Applicants submit that Claims 1-15, 19-23, and 31-32 now define patentable subject matter. Accordingly, Applicants respectfully request allowance of these claims.

The foregoing is submitted as a full and complete Response to the Office Action mailed November 1, 2001, and early and favorable consideration of the claims is requested.

Serial No.: 09/475,830

Attorney Docket No.: 11710-0111

Page 7

Should the Examiner believe that anything further is necessary in order to place the application in better condition for allowance, the Examiner is respectfully requested to contact Applicants' representative at the telephone number listed below.

No additional fees are believed due; however, the Commissioner is hereby authorized to charge any deficiency, or credit any overpayment, to Deposit Account No. 11-0855.

Respectfully submitted,



---

Theodore M. Green

Reg. No.: 41,801

Attorney for Applicants

KILPATRICK STOCKTON LLP

1100 Peachtree Street, Suite 2800

Atlanta, Georgia 30309

Telephone: (404) 815-6500

KC No.: 14,469

Attorney Docket No. 11710-0111; 44043-228514